

REMARKS**Status of the claims**

Claims 1-6, 8, 14-19, 21-26, 28, 34-37, 43-44 and 50-51 are pending in the application. Claims 2-6, 8, 14-19, 21-26, 28, 43-44, and 50-51 are withdrawn from consideration. Claims 1 and 34-37 are rejected. No claims are amended.

The 35 U.S.C. §103 rejection

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamazaki et al.* (US 2004/0249320) as modified by *Parkin et al.* (US 2002/0133176). The Applicants respectfully traverse this rejection.

The Examiner states that *Yamazaki et al.* disclose a device comprising an actuator for driving an abrasive surface, a container adapted to deliver an abrasive material, and a reservoir/permeable membrane adapted to contain a pharmaceutical. The Examiner concedes that *Yamazaki et al.* does not disclose a container connected to the device for collected ablated tissue from the ablation site, but that *Parkin et al.* teach that it is known to incorporate a vacuum source and collection container for removing ablated tissue. Thus, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of *Yamazaki et al.* with a collection container as taught by *Parkin et al.* since such modification would make the device easier and more hygienic to use. The Applicants respectfully disagree.

The Applicants submit that *Yamazaki et al.* disclose a cosmetic treatment device for generating vibration comprising a motor, alumina based abrasive grains, and

housing for the motor. More particularly, *Yamazaki et al.* disclose the device to contact the skin surface of a user so as to penetrate a beauty treating agent into the skin.

The Applicants submit that *Parkin et al.* disclose a micro-dermabrasion system for the removal of surface portions of dead or living tissues. *Parkin et al.* disclose that conventional microdermal abrasion apparatuses employ a stream of abrasive particles such as sand applied to the surface of the tissue or skin by means of a vacuum pump through an opening which is sealed against the skin. Furthermore, the spent particles and removed tissues may be collected by vacuum pressure by the device and delivered to a collection container for later disposal.

The Applicants submit, as conceded by the Examiner in a phone interview, that *Yamazaki et al.* is not a proper prior art against the present application. The Applicants respectfully point out that 35 U.S.C. §102(e) which states that a proper prior art references must have been described:

"in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language..."

Thus, a proper prior art reference can only claim the benefit of a prior PCT application if the international application designated the United States and was published in English. The Applicants submit that the PCT application of *Yamazaki et al.* was not published in English and therefore *Yamazaki et al.* do not benefit from the priority of foreign filing date.

Yamazaki et al. was filed in the United States on April 4, 2004. The PCT (PCT/JP2002/003739) filing and publication dates are April 15, 2002 and February 27, 2003, respectively. Meanwhile, the present application was filed on July 30, 2004 and claims the benefit of an earlier filed U.S. provisional No. 60/413,351, filed on September 25, 2002. Therefore, the priority date of the present application antedates both the US (April 4, 2004) and foreign reference dates (February 27, 2003) of **Yamazaki et al.** Accordingly, the Applicants respectfully request that **Yamazaki et al.** be removed as prior art.

The Applicants respectfully submit that the remaining prior of **Parkin et al.** does not render the claimed invention obvious because the prior art does not suggest or teach or make obvious a device comprising an actuator for driving an abrasive surface, a container adapted to deliver an abrasive material, and a reservoir/permeable membrane adapted to contain a pharmaceutical. In view of the arguments presented herein, the Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103 be removed. The Applicants also request that the finality of this rejection be withdrawn.

Claims 34-37 are rejected under 35 U.S.C. §103 as being unpatentable over **Yamazaki et al.** as modified by **Parkin et al.** and further in view of **Avrhami et al.** (US 2003/0212397). The Applicants respectfully traverse this rejection.

The Examiner states that while **Yamazaki et al.** as modified by **Parkin et al.** do not explicitly disclose monitoring feedback using an electrical property, **Avrhami et al.** teach monitoring feedback using heartbeat to perform safe ablation procedure.

Thus the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of **Avrhami et al.** in the device of **Yamazaki et al.** as modified by **Parkin et al.** to increase the safety of the ablation procedure for better patient outcome. The Applicants respectfully disagree.


As discussed *supra*, **Yamazaki et al.** is an improper prior art against the present Application. The Applicants respectfully request that **Yamazaki et al.** be removed as a prior art reference in this rejection. Furthermore, the combination of the remaining prior art references, **Parkin et al.** and **Avrhami et al.** do not render the claimed invention obvious because the prior art does not suggest or teach or make obvious a device comprising an actuator for driving an abrasive surface, a container adapted to deliver an abrasive material, and a reservoir/permeable membrane adapted to contain a pharmaceutical.

In view of the arguments presented herein, the Applicants respectfully request that the rejection of claims 34-37 under 35 U.S.C. §103 be removed. The Applicants also request that the finality of this rejection be withdrawn. The Applicants submit that all pending claims are now in condition for allowance.

This is intended to be a complete response to the Final Office Action, mailed March 10, 2010. If any issues remain outstanding, the Examiner is respectfully requested to telephone the undersigned attorney of record for immediate resolution. The Applicants submit that no fee is due. If this is in error, please debit any applicable fees from Deposit Account No. 07-1185 upon which the undersigned is allowed to draw.

Respectfully submitted,

Date: Jun 10, 2010
ADLER & ASSOCIATES
8011 Candle Lane
Houston, Texas 77071
Tel: (713) 270-5391
Fax: (713) 270-5361
ben@adlerandassociates.com


Benjamin Aaron Adler, Ph.D., J.D.
Registration No. 35,423
Counsel for Applicant